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Paper No. 16
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re S. Smith & Son Pty Ltd.

Serial No. 75/467,141

Neil F. Martin of Brown Martin Haller & McClain for applicant.

Angela Bishop Wilson, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Quinn, Hairston and Holtzman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by S. Smith & Son Pty Ltd. to register the mark NAUTILUS for "wines."[1]

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark shown below

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[1] Application Serial No. 75/467,141, filed April 13, 1998, based on Australian Registration No. 454899 issued November 6, 1986.

for "beverages, namely, non-carbonated vitamin and mineral isotonic soft drinks; carbonated soft drinks; [and] mineral waters" as to be likely to cause confusion.[2]

When the refusal to register was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

Applicant, relying on a specimen from the file of the cited registration, contends that fitness and post-exercise beverages would not be confused with wines.[3] According to applicant, the involved beverages are sufficiently distinct that there is no likelihood of confusion.

The Examining Attorney maintains that applicant's focus on registrant's isotonic drinks is misplaced inasmuch as the entirety of the identification of goods in the cited registration must be considered in determining likelihood of confusion. The Examining Attorney points out that registrant's goods include carbonated soft drinks and

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[2] Registration No. 1,760,759, issued March 23, 1993; Section 8 affidavit filed and accepted.

[3] The specimen was first submitted with applicant's appeal brief. Generally, such submissions are untimely. Trademark Rule 2.142(d). In this case, however, the Examining Attorney did not object to the untimely submission, but rather considered the evidence in her brief. Accordingly, we likewise have considered the specimen in making our decision. The specimen does not serve, however, to restrict in any way the cited registration. As the Examining Attorney has pointed out, if more than one item of goods is specified in an application in one class, it is not ordinarily necessary to have specimens for each product. *TMEP* §905.01(a).

mineral water, and contends that these goods are related to wines. In connection with her arguments, the Examining Attorney submitted third-party registrations showing that the same entity has adopted a single mark to identify both types of goods. Also of record are advertisements showing that both applicant's and registrant's types of goods are offered for sale in the same retail stores. Lastly, the Examining Attorney relied upon recipes from a bartender's guide showing that these beverages are used together in the same cocktails.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In the present case, the marks are identical in terms of sound and meaning, both marks' appearing to be arbitrary for the respective beverages. In terms of appearance, the stylization of the cited registration hardly is sufficient to distinguish the marks. We say this keeping in mind the

normal fallibility of human memory over time and the fact that consumers retain a general, rather than specific, impression of trademarks encountered in the marketplace. Moreover, the record is devoid of any evidence of any third-party uses or registrations of the mark NAUTILUS or similar marks in the beverage field.

Due to the virtual identity between the marks, if there is a viable relationship between applicant's goods and registrant's goods, a likelihood of confusion would exist. Indeed, "even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

With respect to the goods, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and cited registration. See, e.g., Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Thus, we must compare applicant's wines with *all* of registrant's goods, including carbonated soft drinks and mineral water, and not just the isotonic drinks as applicant primarily has done. Cf: Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648

F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)[likelihood of confusion must be found if public confused as to *any item* that comes within the identifications of goods in the involved application and registration].

At the outset, we recognize that there is no per se rule in cases involving wines and non-alcoholic beverages. In re Jakob Demmer KG, 219 USPQ 1199 (TTAB 1983). In the present case, we find that the record establishes a sufficient relationship between applicant's wines and registrant's carbonated soft drinks and mineral water that the contemporaneous use of the marks thereon is likely to cause confusion. The record shows that wine, on the one hand, and soft drinks and mineral water on the other, are complementary beverages which may be purchased and used together. Wine is frequently used with beverages of the type sold by registrant to form various wine cocktails as shown by the bartender's recipe guide. In addition, the advertisements show that the goods are sold in the same stores. See: In re Modern Development Company, 225 USPQ 695 (TTAB 1985)[THE CANTEEN (stylized) for wine in cans and CANTEEN for soft drinks is likely to cause confusion].

We also have taken into account the several third-party registrations based on use which the Examining Attorney has submitted. The registrations show marks which

are registered for wines, soft drinks and mineral waters. Although these registrations are not evidence that the marks shown therein are in use or that the relevant purchasers are familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

We have considered applicant's assertion that there has been no actual confusion between its mark and registrant's mark, but have accorded it limited probative value. As a *du Pont* factor, the absence of actual confusion weighs, of course, in applicant's favor. The probative weight is limited, however, by the fact that there are no specifics regarding the extent of use by applicant or registrant. Thus, there is no way to assess whether there has been a meaningful opportunity for confusion to occur in the marketplace. In any event, the test under Section 2(d) of the Trademark Act is the likelihood of confusion. Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), aff'g, 12 USPQ2d 1819 (TTAB 1989); and

Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992).

We conclude that purchasers familiar with registrant's carbonated soft drinks and mineral water sold under the mark NAUTILUS (stylized) would be likely to believe, upon encountering applicant's mark NAUTILUS for wines, that the goods originated with or were somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.